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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,896	09/28/2001	Travis J. Parry	10012806-1	4357

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[REDACTED] EXAMINER

HANG, VU B

ART UNIT	PAPER NUMBER
	2625

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/966,896	PARRY, TRAVIS J.
	Examiner	Art Unit
	Vu B. Hang	2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 September 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-24 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 28 September 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 - Certified copies of the priority documents have been received in Application No. _____.
 - Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/28/01, 11/15/05</u> . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

- This office action is responsive to the following communication: Request for Continued Examination filed on 09/12/2006.
- The amendments filed on 04/07/2006 have been entered and made of record.
- Claims 1-24 are pending in the application.

Response to Arguments

1. Applicant's arguments filed on 04/07/2006, with respect to the rejections of independent claims 1, 15, 19, 21 and 24 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Jecha et al (US Patent 7,120,634 B2) and Maruyama (US Patent 7,016,057 B1).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-2, 5-7, 9-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Jecha et al. (US Patent 7,120,634 B2).

3. Regarding **Claim 1**, Jecha discloses a method a print job to a printer (see Fig.3 and Col.1, Line 58-61), comprising: attaching at least one document to an e-mail message (see Col.5, Line 59-64); specifying instructions in a portion of the e-mail message for printing the at last one document with the user selected printing attributes (see Col.5, Line 35-40); sending the e-mail message over the network to an e-mail enabled printer (see Fig.2 (204,206,216) and Col.5, Line 59-64), where the e-mail enabled printer includes e-mail client software (see Col.4, Line 20-32); and extracting the at least one document from the e-mail message by the e-mail enabled printer (see Col.5, Line 1-8).

4. Regarding **Claims 2, 17 and 22**, Jecha further discloses storing the at least one document in the job retention of the e-mail enabled printer by the e-mail enabled printer (see Col.5, Line 59 – Col.6, Line 2).

5. Regarding **Claim 5**, Jecha further discloses printing the at least one document in conjunction with storing the at least one document in the job retention of the e-mail enabled printer by the e-mail enabled printer (see Col.5, Line 59 – Col.6, Line 2).

6. Regarding **Claim 6**, Jecha further discloses specifying instructions for printing the at least one document in a portion of the e-mail message (see Col.2, Line 1-6, Col.5, Line 35-40).

7. Regarding **Claim 7**, Jecha further discloses specifying printing attributes for the printing of the at least one document (see Col.2, Line 1-6, Col.5, Line 35-40).

8. Regarding **Claim 9**, Jecha further discloses providing printable readable language in the portion of the e-mail message (see Col.2, Line 1-6 and Col.5, Line 59-64).

9. Regarding **Claim 10**, Jecha further discloses encoding the printable readable language prior to sending the e-mail over the network (see Col.2, Line 1-6 and Col.4, Line 57-64).

10. Regarding **Claims 11 and 23**, Jecha further discloses encoding the printable readable language in MIME encoding fields (see Col.2, Line 1-6 and Col.5, Line 59 – Col.6, Line 2).
11. Regarding **Claim 12**, Jecha further discloses at least one document is attached to the e-mail message in an application-specific format (see Col.5, Line 59-64).
12. Regarding **Claims 13 and 16**, Jecha further discloses converting the application specific format into a print ready file by an e-mail enabled printer (see Col.5, Line 4-8).
13. Regarding **Claim 14**, Jecha further discloses wherein at least one document is attached to the e-mail message in a bit-mapped image format (see Col.6, Line 31-40).
14. Regarding **Claims 15, 18, 19, 20, 21 and 24**, Jecha discloses a method of distributing a document for printing (see Fig.3 and Col.1, Line 58-61), comprising: attaching at a workstation at least one document to an e-mail message (see Col.5, Line 59-64); specifying instructions in a portion of the e-mail message for printing the at least one document with user selected printing attributes (see Col.5, Line 35-40); sending the e-mail message to the e-mail enabled print server of a local network (see Fig.2 (204,206,216) and Col.5, Line 59-64); extracting the at least one document at the e-mail enabled print server (see Col.4, Line 48-64); and sending the at least one document to the network printer of a local network by the e-mail enabled print server (see Col.5, Line 1-8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jecha et al (US Patent 7,120,634 B2) in view of Maruyama (US Patent 7,016,057 B1).

16. Regarding **Claim 3**, Jecha discloses the method of Claim 2 and reading the instructions by the e-mail enabled printer (see Col.4, Line 57- Col.5, Line 8), but fails to disclose specifying instructions for storing the at least one document in the job retention in a portion of the e-mail message. Maruyama, however, discloses specifying instructions for storing the at least one document in the job retention in a portion of the e-mail message (see Fig.12, Col.5, Line 12-17 and Col.9, Line 12-17).

Jecha and Maruyama are combinable because they are from the same field of endeavor, namely network printing systems. At the time of the invention, it would have been obvious for one skilled in the art to include specifying instructions for storing the at least one document in the job retention in a portion of the e-mail message. The motivation would be to instruct the printer to store a document in a particular format to be interpreted by the printer for printing.

17. Regarding **Claim 4**, Maruyama further discloses reading the instructions for storing the at least one document by the e-mailed enabled printer (see Fig.2 (1e), Col.5, Line 12-17 and Col.9, Line 12-17).

18. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jecha et al (US Patent 7,120,634 B2) in view of Fabbio et al. (US Patent 5,870,089).

19. Regarding **Claim 8**, Maruyama further discloses Jecha discloses the method of Claim 2 but fails to disclose specifying the scheduling instructions for scheduling the printing of the at least one document. Fabbio, however, discloses a means to schedule the transferring of data

packages from a storage queue to destination devices (i.e. printer, fax) in a network (see Fig. 5 (118) and Col.8, Line 10-37).

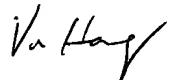
Jecha and Fabbio are combinable because they are from the same field of endeavor, namely network printing apparatus. At the time of the invention it would have been obvious for one skilled in the art to incorporate the use of a scheduling process to prioritize or schedule the print process. The motivation for doing so would be to have a set process of determining the priority of the documents to be printed. Since many documents could be stored to the job retention of the printer, it would be useful to prioritize documents and have them print in specific orders.

Conclusion

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vu B. Hang whose telephone number is (571) 272-0582. The examiner can normally be reached on Monday-Friday, 9:00am - 6:00pm.
21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached on (571) 272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Vu Hang
Assistant Examiner



TWYLER LAMB
SUPERVISORY PATENT EXAMINER